REMARKS/ARGUMENTS

This paper is responsive to the Office Action mailed March 21, 2012. Claims 1-5, 7-9, 31-36, 41-55 and 75-105 were pending before submission of this paper. Final rejections of claims 1-5, 7-9, 31-36, 41-49, 51-55, 75, 80-91, 93, 97-101, 103 and 105 were affirmed by the Board of Patent Appeals and Interferences and maintained in the Office Action. Claims 1-5, 7-9, 31-36, 41-55 and 75-105 are rejected. Specifically, claims 1-5, 45-49, 55, 75, 80, 81, 87-89, 91, 93, 97-99, 101, 103 and 105 stand rejected under 35 U.S.C. § 103(a) as allegedly obvious over Roth et al. (U.S. Pat. 6,285,987) in view of Davis et al. (U.S. Pat. 6,259,361). Claims 7, 8, 31-35, 41-43, 51, 52 and 82-86 are alternatively rejected under 35 U.S.C. § 103(a) as being unpatentable over Roth et al and Davis et al, further in view of Copple et al (U.S. Pat. 6,178,408).

Final Rejections of claims 50, 76-79, 92, 94-96, 102 and 104 was reversed by the Boar of Patent Appeals and Interferences. Claim 50 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Roth et al. in view of Davis et al. Claims 76, 77 and 92 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Roth et al. in view of Davis et al and in view of Walker et al. (U.S. Pat. 6,324,520 B1). Claims 78, 79, 94-96 and 104 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Roth in view of Davis et al. and in view of Carlton-Foss (U.S. 6,647,373 B1). Claim 50 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Roth et al. in view of Carlton-Foss.

Applicants respectfully disagree. Claims 1, 2-5, 7, 9, 45, 75-76, 78, 82, 91-92, 94-95, and 101-102 have been amended. Support for all amended claims can be found in the specification, and no new matter has been added by these amendments. Reconsideration of the claims in view of the amendments and the following remarks is respectfully requested.

I. Examiner Interview

A telephone interview was conducted with Examiner Uber on May 11, 2012, at 1 PM Eastern Time. The undersigned attorney represented Applicants in the interview. In the interview, an overview of the claimed subject matter was given, along

with a discussion of the differences with respect to Roth, Davis, Walker and Carlton-Foss. The claims, in particular claims 1, 45, 50, 76, 78, 79, 92, 94-96, 102 and 104, were then discussed in light of at least some of these differences. No agreement was reached. Applicants appreciate Examiner Uber's interview and present this response accordingly.

II. Independent Claims 1, 45, 75, 91, and 101 Are Allowable Under 35 U.S.C. § 103 Over Roth in View of Davis

Claims 1, 45, 75, 91, and 101 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Roth in view of Davis.

With regard to rejections under 35 U.S.C. § 103, the Examiner must provide evidence which as a whole shows that the legal determination sought to be proved (*i.e.*, the reference teachings establish a *prima facie* case of obviousness) is more probable than not. M.P.E.P. § 2142. Accordingly, "the key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." M.P.E.P. § 2142; *see KSR International Co. v. Teleflex, Inc.*, 550 U.S.398, 82 USPQ 2d 1385, 1395-97 (2007). Applicants respectfully submit that, for at least the following reasons, Roth does not render claims 1, 45, 75, 91, and 101 obvious under 35 U.S.C. § 103 and Davis does not remedy the deficiency of Roth.

A. Independent Claim 1

Applicants' claim 1, as amended, now recites

> 1. A method in a computer system for allocating display space on web page instances, the method comprising:
>
> receiving multiple bids each indicating an original bid amount, an advertisement, and a requested number of web page instances on which the advertisement is to be placed during a time period;
>
> receiving a request to provide a web page instance to a user, the web page instance including a display space slot for displaying ranked advertisements;
>
> dynamically normalizing the bids to form normalized bids based at least in part on of original bid amounts and on a likelihood that the advertisement will be placed on the requested number of web page instances during the time period;

selecting a normalized bid whose original bid amount is not the highest of the bids for a rank and whose advertisement is eligible to be placed in the display space slot of the web page instance;

adding the advertisement of the selected bid to the display space slot of the web page instance; and

charging the source of the selected bid the original bid amount indicated by the selected bid.

Without conceding the rejection, Applicants have amended claim 1 to recite "selecting a normalized bid whose original bid amount is not the highest of the bids for a rank." In the Decision on Appeal on p. 7, the appeal notes that Applicant's argument that "each rank uses the highest bid for that rank" was not within the scope of the appealed claim and the limitation was met by Davis. Without conceding the decision, Applicants have amended claim 1 to "selecting a normalized bid whose original bid amount is not the highest of the bids for a rank" as was used in the Decision on Appeal, which removes the ability of Davis to meet the limitation. Support for the amendment may be found at least on p. 12 lines 7-15. More specifically, Davis teaches a system that "compares this bid amount with all other bid amounts for the same search term, and generates a rank value for all search listings having that search term" and then the "rank value generated by the bidding process determines where the network information providers listing will appear on the search results list." (Davis Abstract). Davis, however, does not teach "selecting a normalized bid whose original bid amount is not the highest of the bids for a rank." As Davis was cited to remedy the deficiency of Roth with respect to this element, Roth is, by the Office's admission, deficient as well.

Applicants have also amended claim 1 to recite "dynamically normalizing the bids to form normalized bids based at least in part on of bid amounts and on a likelihood that the advertisement will be placed on the requested number of web page instances during the time period." On page 16, the Office Action suggests Carlton-Foss shows "normaliz[ing] bids as they are received" as a definition of "dynamically" to make up for a deficiency of Roth. Applicants note that Applicants' claims are not limited to "normalize[ing] bids as they are received" (see, e.g. Application p. 11 lines 10-11 and p. 25 lines 15-17). Even assuming, *arguendo*, that "dynamically normalizing the bids"

reads on "normaliz[ing] bids as they are received," the cited section does not support the proposition cited by the Office. In particular, the cited section discloses "the high bid, the low bid, the average bid, and other statistics are used to calculate a number normalized to a range." (Carlton-Foss col. 11, lines 21-29) Therefore, Carlton-Foss requires all of the bids to "calculate a number normalized to a range." (Carlton-Foss col. 11, lines 21-29). This requirement of all of the bids does not support the assertion of " dynamically." Carlton-Foss, therefore, does not "dynamically normaliz[e] the bids to form normalized bids based at least in part on of bid amounts and on a likelihood that the advertisement will be placed on the requested number of web page instances during the time period."

Applicants also submit that Roth, Davis nor Carlton-Foss do not disclose use of "normalized bids based at least in part on bid amounts and on a likelihood that the advertisement will be placed on the requested number of web page instances during the time period" as recited in claim 1. Roth, Davis and Carlton-Foss do not appear to discuss this combination.

In addition, Roth and Carlton-Foss would appear to be incompatible because the use of one would go against the stated advantages of the other. Carlton-Foss normalizes evaluation categories to combine them "into a single rating" (col. 12 line 47) while a combination of Carlton-Foss and Roth would combine evaluation categories (price and number of impressions) and then normalize, which is the opposite of what Carlton-Foss intends. For example, Roth manipulates (col. 8, lines 32-40) a bid amount to the "minimum amount necessary to maintain the level of buying." By manipulating the bid amount Roth compensates for another evaluation category of impressions, *i.e.* Roth "ensure[s] the desired number of impressions during the time allotted to the media buy." (col. 8 lines 36-37). Carlton-Foss, on the other hand, "calculate[s] a number normalized to a range, for example between 1 and 10, to provide the financial evaluation of the bid" (col. 11, lines 24-26) as one of several "evaluation categories" (Carlton-Foss col. 12 lines 19-21). The evaluation categories are weighted based on "how heavily it should be weighted in selecting a winning bid" (col. 12 lines 17-18) and then merged with other evaluation categories "into a single rating" (col. 12 line 47).

To combine Roth and Carlton-Foss, the advantage of each may be lost. The advantage of Carlton-Foss's compartmentalization into and weighting of evaluation

categories "such as price, service, warranty, configuration, installation, availability, delivery and other characteristics" (col. 12 lines 19-21) would be degraded by making the price category a substitute for a category of the "number of impressions" (Roth col. 8 lines 36-37). More simply, Carlton-Foss normalizes evaluation categories to combine them "into a single rating" (col. 12 line 47) while Roth uses an evaluation category (price) as a substitute for a second evaluation category (number of impressions). Separating the categories of price and number of impressions would go against the stated advantages of Roth, while combining categories before normalization would go against the stated advantages of Carlton-Foss. It is unclear how Roth's minimize bid and Carlton-Foss' normalized bid would be compatible, or merged together to achieve the same result without destroying the advantage behind each manipulation.

For the forgoing reasons, this amendment of claim 1 is not anticipated by 35 U.S.C. § 103 over Roth in view of Davis at least because the Roth reference does not disclose, teach, or even suggest such subject matter as recited in amended claim 1. Davis also fails to make up for the deficiency of Roth as described above. Applicants, therefore, respectfully submit that claim 1 is allowable under 35 U.S.C. § 103 over Roth in view of Davis.

B. Independent Claims 45, 75, 91, and 101

Applicants respectfully submit that claims 45, 75, 91, and 101 are allowable under 35 U.S.C. § 103 at least for reasons including some of those discussed above in connection with claim 1. For example, claim 45 recites, as amended, "wherein at least one selected bid for the rank does not have the highest bid amount of those bids whose advertisement are eligible to be displayed in the rank of the advertising space slot." Claim 75 recites, as amended, "charging the source of the selected advertising plan the original bid amount associated with the selected advertising plan." Claim 91 recites, as amended, "whose bid amount is not a highest bid amount for the rank of the identified advertising plans wherein selecting such an identified advertising plan tends to increase overall advertising revenue and lower revenue for the advertisement." Claim 101 recites, as amended, "for each eligible advertising plan, normalizing, on demand, bids from the advertising plans to form normalized bids

based at least in part on its bid amount, its placed number and the time remaining in its time period." At least for reasons including some of those discussed above in connection with claim 1, Applicants respectfully submit that claims 45, 75, 91, and 101 are allowable over Roth in view of Davis.

III. Independent Claim 102 is Allowable Under 35 U.S.C. § 103 Over Roth in View of Carlton-Foss

Claims 1, 45, 75, 91, and 101 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Roth in view of Davis.

Without conceding the rejection, Applicants have amended claim 102 to recite "generating each normalized bid amount on demand for the provided bids whose advertisements are eligible to be placed on the web page instance wherein placing the advertisement of the bid with a highest normalized bid amount in the display space slot of the web page instance is anticipated to maximize overall revenue and reduce the display slot revenue for the web page instance." Support for the amendment may be found in the specification, including at least in Figure 9 and p. 21 lines 11-27. The Office Action on p. 19 admits that Roth does not disclose normalizing bids. Therefore, Roth cannot disclose "generating each normalized bid amount on demand." Carlton-Foss also fails to remedy the deficiency of Roth. Carlton-Foss states "the high bid, the low bid, the average bid, and other statistics are used to calculate a number normalized to a range." (Carlton-Foss col. 11, lines 21-29) and therefore must know all numbers to know the "the high bid, the low bid, the average bid." *Id.* Applicants cannot find where Carlton-Foss suggests comparing anything but the entire set of bidders to normalize the bids. Therefore Carlton-Foss does not disclose "generating each normalized bid amount on demand."

Accordingly, because Roth and Carlton does not, individually or in combination, disclose, teach, or even suggest at least such subject matter as recited in claim 102 and for the reasons discussed above, Applicants respectfully submit that claim 102 is allowable under 35 U.S.C. § 103 over Roth and Carlton.

IV. Dependent Claims 2-5, 7-9, 31-36, 41-44, 46-55, 76-90, 92-100 and 103-105 Are Allowable Under 35 U.S.C. § 103 over Roth, Davis, Walker and Carlton-Foss

Each of claims 2-5, 7-9, 31-36, 41-44, 46-55, 76-90, 92-100 and 103-105 depend from one of claims 1, 45, 75, 91, 101 and 102, discussed above. Accordingly, Applicants respectfully submit that claims 2-5, 7-9, 31-36, 41-44, 46-55, 76-90, 92-100 and 103-105 are each allowable at least for depending from an allowable independent claim. In addition, Applicants respectfully submit that at least some of claims 2-5, 7-9, 31-36, 41-44, 46-55, 76-90, 92-100 and 103-105 recite subject matter that is patentable in its own right. Accordingly, in light of the foregoing, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 103 over Roth, Davis, Walker and Carlton-Foss.

Regarding claim 95, the Examiner defines "dynamically" as "normalizes bids as they are received". Applicants note that Applicants' claims are not limited to "normaliz[ing] bids as they are received" (see, e.g. Application p. 11 lines 10-11 and p. 25 lines 15-17). Even assuming, *arguendo*, that "dynamically normalizing the bids" reads on "normalize[ing] bids as they are received," the cited section does not support the proposition cited by the Office. In particular, the cited section discloses "the high bid, the low bid, the average bid, and other statistics" are gathered (Carlton-Foss col. 11, lines 21-29), which would require all of the bids to be analyzed at once and not "as they are received." Applicants fail to see the support in the cited art for the assertion of dynamically in the cited section of Carlton-Foss. Therefore the Office Action is defective as to pointing out why the claim would have been obvious.

V. Amendment To The Claims

Unless otherwise specified or addressed in the remarks section, amendments to the claims are made for purposes of clarity, and are not intended to alter the scope of the claims or limit any equivalents thereof. The amendments are supported by the specification and do not add new matter. In addition, by focusing on specific claims and claim elements in the discussion above, Applicants do not imply that other claim elements are disclosed or suggested by the references. In addition, any

characterizations of claims and/or cited art are being made to facilitate expeditious prosecution of this application. Applicants reserve the right to pursue at a later date any other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by another prosecution. Accordingly, reviewers of this or any child or related prosecution history shall not reasonably infer that Applicants have made any disclaimers or disavowals of any subject matter supported by the present disclosure.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

Further, the Commissioner is hereby authorized to charge any additional fees or credit any overpayment in connection with this paper to Deposit Account No. 20-1430.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-4741.

Respectfully submitted,

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